

### **REMARKS**

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-3, 7 and 9-23, as well as newly added Claims 39 -54, the only claims pending and currently under examination in this application.

Claims 1 and 14 have been amended to specify that the minimum length of the probe is 65 nt. Support for this limitation is found in the previously pending claims. See e.g., Claim 23. New Claims 39-46 find support in the previously pending claims as well as at page 8, lines 15 ff of the specification. New Claims 47-54 find support in the previously pending claims as well as at page 8, lines 27 ff of the specification. As the above amendments introduce no new matter to the application, their entry by the Examiner is respectfully requested.

Claims 1-3, 8 and 10-23 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Church et al. All of these rejected claims now include the limitation of previously pending Claim 23 limiting the minimum length of the probes to 65 nt.

At Col. 8, lines 19 to 40, Church teaches:

- Preferably, the solid support is a silica support.
- 3 It is preferred that the first strand of each member contains at its 3' end a binding site for an oligonucleotide primer which is used to prime enzymatic synthesis of the second, and at its 5' end a variable sequence, wherein the binding site is present in each member of the array.
- 5 Preferably, enzymatic synthesis is performed using an enzyme.  
In a preferred embodiment, the oligonucleotide primer of is between 10 and 30 nucleotides in length.
- 7 It is preferred that the first strand comprises DNA.  
It is additionally preferred that the second strand comprises DNA.  
Preferably, the first and second strands each comprise from 16 to 60 monomers selected from the group that includes ribonucleotides and deoxyribonucleotides.
- 9 In a highly preferred embodiment, the solid support is a silica support and the first and second strands each comprise from 16 to 60 monomers selected from the group that includes ribonucleotides and deoxyribonucleotides.

As such, Church teaches an upper limit of 60 nt. The above description talks about the overall length of the strands and any components thereof, e.g., spacers, etc., such that the overall length does not exceed 60nt, not just that a certain portion does not exceed 60 nt. One would not read the above as allowing for an additional spacer domain that would increase the length beyond 60 nt.

As all of the rejected claims are limited such that the minimum length is 65 nt, Church does not anticipate these claims and this rejection may be withdrawn.

Accordingly, this rejection may be withdrawn.

Claim 35 has been rejected under 35 U.S.C. § 103 (a) over Church in view of the Stratagene catalog. In view of the cancellation of Claim 35, this rejection may be withdrawn.

## CONCLUSION

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,

BOZICEVIC, FIELD & FRANCIS LLP

Date: November 5, 2004

By: 

Bret E. Field  
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
1900 University Avenue, Suite 200  
East Palo Alto, CA 94303  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231